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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 09/875,220   | 06/06/2001  | Mirko Lehmann        | SMB-PT025 (A 01 207 H US) | 6063             |
| 3624   | 7590        | 10/23/2003           | EXAMINER                  |                  |
| VOLPE AND KOENIG, P.C.<br>UNITED PLAZA, SUITE 1600<br>30 SOUTH 17TH STREET<br>PHILADELPHIA, PA 19103 |             |                      | GITOMER, RALPH J          |                  |
|  |             |                      | ART UNIT                  | PAPER NUMBER     |
|  |             |                      | 1651                      |                  |

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/875,220 | <b>Applicant(s)</b><br>LEHMANN, MIRKO |  |
|                              | <b>Examiner</b><br>Ralph Gitomer     | <b>Art Unit</b><br>1651               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

The foreign search report submitted appears to be incomplete, please send the full original report. Priority is claimed to 6/9/2000.

5           The claims are directed to ~~the~~ membrane enclosed biocompartments~~the~~ which reads on cells as well as organelles of cells.

10           The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

15           (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Zen.

20           Zen (EP 0 870 823 A1) entitled ~~the~~ System for Monitoring the Metabolic Activity of Living Cells~~the~~ teaches in column 2 lines 37-45, an electrode type sensor for measuring pH. In column 6 lines 41-55, the determination can be repeated and it is possible to determine the variation of the basal metabolism of a cell  
25           population induced by an external agent. In claim 7 lines 12-22, external agents added to the culture medium can be determined.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5           Claims 1-9 are rejected under 35 U.S.C. 102(a) as being anticipated by Lehmann.

          Lehmann (Biosensors & Bioelectronics) with a different inventive entity from the present application, teaches the present invention.

10           All the presently claimed features are taught by the above references for the same function as claimed. Note the claims are directed to ~~examining~~ and no further results are seen.

          Claims 1-9 are rejected under 35 U.S.C. § 112, second  
15   paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

          The claims must be carefully rewritten in accordance with  
20   standard US patent practice. For example, the method claims do not recite positive gerunds as method steps. ~~Made ready~~ is not a method step. Some of the subscripts as in 1(e) are not understood. The last step of claim 1 is incompatible with the preamble of the claim. ~~The said~~ is redundant. ~~Namely~~ is not  
25   descriptive.

The following prior art pertinent to applicant's disclosure is made of record and not relied upon:

Liffmann (5,037,737) teaches sensors.

Pottgen (6,153,069) teaches sensors.

5 Sugihara (6,297,025) teaches sensors.

Al-Baldawi (J of Physiology) teaches measuring pH of organelles.

Ryback (Biophysical J) teaches determining buffer capacity of cells by measuring pH.

10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm. The examiner can also be reached on alternate Mondays. If  
15 attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (703) 308-4743. The fax phone number for this Art Unit is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist  
20 whose telephone number is (703) 308-1235. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at

Serial No. 09/875,220  
Art Unit 1651

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www.uspto.gov and click on the button Patent Electronic Business  
Center for more information.

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*Ralph Gitomer*

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